

REMARKS

At the time of the Second Office Action dated February 28, 2008, claims 1-20 were pending and rejected.

CLAIMS 9-12 ARE REJECTED UNDER 35 U.S.C. § 101

On page 2 of the Second Office Action, the Examiner asserted that the claimed invention, as recited in claims 9-12, is directed to non-statutory subject matter. This rejection is respectfully traversed.

At the outset, Applicants are unclear as to what has occurred between the issuance of the First and Second Office Actions that has caused the Examiner to reject claims 9-12 under 35 U.S.C. § 101 in the Second Office Action when the Examiner did not reject claims 9-12 in the First Office Action.

On page 3 of the Second Office Action, the Examiner asserted that "the instant specification intransigence evidences that claim 9 is software per se hence it is non-statutory." Applicants are unclear as to what the Examiner means by "the instant specification intransigence."

Notwithstanding this ambiguity as to the Examiner's logic, the Examiner's conclusion evidences that the Examiner has failed to set forth the "broadest reasonable interpretation of the claims" consistent with Appellants' specification. Instead, the Examiner's interpretation is, in

fact, a very narrow interpretation of the claims. In this regard, reference is made to paragraph [0041] of Appellants' specification, which states "[a]n implementation of the method and system of the present invention can be realized in centralized fashion in one computer system, or in a distributed fashion where different elements are spread out across several interconnected computer systems." By construing the claims to exclude hardware (i.e., "claim 9 is software per se"), the Examiner is improperly narrowing the scope of claimed subject matter.

The recent decision of the Federal Circuit of In re Comiskey¹ is informative as to these issues. Although the Court held that several claims were directed to non-statutory subject matter, the Court determined that other of the claims² were directed to statutory subject matter. In determining the latter, the Court stated the following:

These claims, under the broadest reasonable interpretation, could require the use of a computer as part of Comiskey's arbitration system. (emphasis added)

Thus, the Court determined that the claims are not required to necessarily recite a computer. Instead, the Court concluded that if the claims, under a broadest reasonable interpretation, could require the use of statutory subject matter (e.g., a computer, a device, a product, etc.), then the claims meet the requirements of 35 U.S.C. § 101. Since the standard, as set forth by the Federal Circuit, only requires that the claims could require statutory subject matter, and since under a broadest reasonable claim construction, the claimed system could include hardware, claims 9-12 meet the requirements of 35 U.S.C. § 101.

¹ Appeal No. 2006-1286 (Fed. Cir. Sep. 20, 2007).

² ("We consider independent claims 17 and 46 separately. They recite the use of 'modules,' including 'a registration module for enrolling' a person, 'an arbitration module for incorporating arbitration language,' and 'an arbitration resolution module for requiring a complainant [or party] to submit a request for arbitration resolution to the mandatory arbitration system.'")

**CLAIMS 1-2, 7, 9, 11 AND 13-14 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY GNAGY ET AL., U.S. PATENT NO. 7,058,633 (HEREINAFTER GNAGY)**

On pages 4-6 of the Second Office Action, the Examiner asserted that Gnagy discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.³ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.⁴ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.⁵ This burden has not been met.

Claims 1, 9, and 13

Each of independent claims 1, 9, and 13 recite a limitation comparable to determining the operation of content block logic. However, referring to page 4 of the Second Office Action, the Examiner did not identify a particular passage within Gnagy that allegedly teaches this limitation. This is particularly notable since the Examiner identified a passage within Gnagy for

³ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

⁴ See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

⁵ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

each of the other limitations found in claim 1. Thus, the Examiner has failed to establish that Gnagy identically discloses the claimed invention within the meaning of 35 U.S.C. § 102.

Claims 9 and 13 also recite "said replacement with said alias circumvents the operation of said content blocking logic," and to teach this limitation, the Examiner identified column 5, lines 31-47 of Gnagy, which for ease of reference, is reproduced below:

FIG. 1 is a block diagram of a re-writing system 100 according to principles of the invention operating in a large network 105 such as the Internet illustrating a first embodiment of the invention. The re-writing system 100 is located in the data pathway 135 between a client 110 and a server 115 connected to the network 105. The re-writing system 100 has a processor 120, a memory 125 and a database 130.

This passage, however, is completely silent about circumventing the operation of content blocking logic. Not only is the passage silent about circumventing the operation of content blocking logic, this passage does not even refer to content blocking logic. Thus, Gnagy further fails to identically disclose the claimed invention, as recited in claims 9 and 13.

For above-described reasons, the Examiner has failed to establish that Gnagy identically discloses the claimed invention, as recited in claim 1-2, 7, 9, 11, and 13-14, within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submits that the imposed rejection of claims 1-2, 7, 9, 11, and 13-14 under 35 U.S.C. § 102 for anticipation based upon Gnagy is not factually viable and, hence, solicit withdrawal thereof.

**CLAIM 8 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON WOLFE
IN VIEW OF IWAMOTO ET AL., U.S. PATENT NO. 5,715,462 (HEREINAFTER IWAMOTO)**

On pages 6 and 7 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Wolfe in view of Iwamoto to arrive at the claimed invention. This rejection is respectfully traversed.

At the outset, Applicants respectfully submit that the Examiner may have intended to reject claim 8 based upon Gnagy in view of Iwamoto since claim 8 ultimately depends from claim 1, and the Examiner withdrew the rejection of claim 1 based upon Wolfe. Based upon this assumption, Applicants respectfully submit that the imposed rejection of claim 8 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Iwamoto is not viable for the same reasons presented above with regard to claim 1.

**CLAIM 20 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY
IN VIEW OF WOLFE AND IWAMOTO**

On pages 7-9 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Wolfe and Iwamoto to arrive at the claimed invention. This rejection is respectfully traversed.

Applicants respectfully submit that the imposed rejection of claim 20 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Wolfe and Iwamoto is not viable for the same reasons presented above with regard to claim 13, upon which claim 20 depends.

**CLAIMS 3 AND 15 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON GNAGY IN VIEW OF BEAUMONT, U.S. PATENT PUBLICATION NO. 2002/0169890**

On pages 9 and 10 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Beaumont to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 3 and 15 depend ultimately from independent claims 1 and 13, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 13 under 35 U.S.C. § 102 for anticipation based upon Gnagy. The secondary reference to Beaumont does not cure the argued deficiencies of Gnagy. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Beaumont, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 3 and 15 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Beaumont is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIMS 4 AND 16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON GNAGY IN VIEW OF META**

On page 10 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Meta to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 4 and 16 depend ultimately from independent claims 1 and 13, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 13 under 35 U.S.C. § 102 for anticipation based upon Gnagy. The secondary reference to Meta does not cure the argued deficiencies of Gnagy. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Meta, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 4 and 16 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Meta is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIM 5 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY IN VIEW OF CAI, U.S. PATENT PUBLICATION NO. 2004/0172468, AND PRABHAKAR ET AL., U.S. PATENT PUBLICATION NO. 2005/0010662 (HEREINAFTER PRABHAKAR)

On pages 11 and 12 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Cai and Prabhakar to arrive at the claimed invention. This rejection is respectfully traversed.

To teach the claimed "determining that content blocking has occurred when a difference between said references and said requests exceeds a threshold value," the Examiner relied upon paragraph [0042] of Prabhakar to teach this limitation. Applicants respectfully disagree. The paragraph in Prabhakar cited by the Examiner merely describes the general concept of tracking applications. However, completely absent from the Examiner's cited passage in Prabhakar is any mention of determining content blocking has occurred based upon a threshold value being exceeded. Applicants, therefore, respectfully submit that the imposed rejection of claim 5 under

35 U.S.C. § 103 for obviousness based upon Gnagy in view of Cai and Prabhakar is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIM 6 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY IN VIEW OF PRABHAKAR

On pages 12 and 13 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Prabhakar to arrive at the claimed invention. This rejection is respectfully traversed.

Similar to claim 5, claim 6 is also directed to the concept of determining that content blocking has occurred. The Examiner's reliance upon paragraph [0043] of Prabhakar to teach this limitation is misplaced. The paragraph in Prabhakar cited by the Examiner merely describes determining when an application is in a redirect loop and not whether or not content blocking has occurred. Applicants, therefore, respectfully submit that the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Prabhakar is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIM 10 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY IN VIEW OF KINGBERG, U.S. PATENT PUBLICATION NO. 2003/0061515

On pages 13 and 14 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Kingberg to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 10 depends ultimately from independent claim 9, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 9 under 35 U.S.C. § 102 for anticipation based upon Gnagy. The secondary reference to Kingberg does not cure the argued deficiencies of Gnagy. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Kingberg, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claim 10 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Kingberg is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIM 12 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GNAGY
IN VIEW OF OMOIGUI, U.S. PATENT NO. 6,694,352. IN VIEW OF KHANNA, U.S. PATENT NO.
7,110,407**

On pages 14-16 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Gnagy in view of Omoigui and Khanna to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 12 depends ultimately from independent claim 9, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 9 under 35 U.S.C. § 102 for anticipation based upon Gnagy. The secondary references to Omoigui and Khanna do not cure the argued deficiencies of Gnagy. Accordingly, even if one having ordinary skill in the art were motivated to modify Gnagy in view of Omoigui and Khanna, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that

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the imposed rejection of claim 12 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Omoigui and Khanna is not viable, and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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